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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,846	12/18/2000	Masashi Uyama	1359.1033	9089

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EXAMINER	
CARLSON, JEFFREY D	

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
02/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/737,846	UYAMA ET AL.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 12/13/04.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1-3, 6-9, 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiStefano, III (US6631400) in view of Gardenswartz et al (US6298330) and Goldstein (US20010032115).**

4. Goldstein includes a provisional 60/171578 filed 12/23/1999. Examiner has proved a copy of this provisional and will be referring to the page and line number of the provisional in order to show proper support back to the 12/23/1999 date.

5. DiStefano, III teaches the storage of customer/prospect (user) profiles which specify the types of ads they are willing to receive. Shops/Marketers access the system and request that ads be sent to targeted subsets of the stored users 1:42-60, 2:37-55, 3:52-60, 4:1-15]. The identification of matching users is taken to provide a searching operation resulting in a prospect/customer distribution list. Gardenswartz et al teaches that the advertising includes store identification where that product offer can be used [col 14 lines 29-54]. It would have been obvious to one of ordinary skill at the time of the invention to have included such information with the advertising of DiStefano, III so

that users are not encouraged to shop at unnamed competitors, as taught by Gardenswartz et al. The step of determining what store(s) the product offer should specify inherently includes searching store information for stores that are capable of selling the identified product which is the subject of the advertising. The mere participation by the shop/retailer in the advertising process provides the step of allowing the shops to determine whether an ad is distributed to the prospective customers; no ads would be sent without the shops desire to send the ads. Goldstein also teaches systems and method for matching stored user profiles to create targeted advertising. Specifcally Goldstein teaches that a user may request nondisclosure of personal information and may be excluded from a generated list of targeted consumers [provisional 60/171578 page 27 lines 5-6]. This is consistent with examiner's previous reliance on Official Notice ragrding opt-in and opt-out. More importantly, Goldstein teaches the idea of the list creation system allowing merchants to advertise their products to *specific groups* including potential (new customers) or past customers (refular customers). It would have been obvious to one of ordinary skill at the time of the invention to have used the systems of DiStefano, III and Gardenswartz et al as well as a merchant's list of regular customers so that when desireing to advertise to potential (new) customers, the past customers (regular customers) can be exclded. As the og eh prior art system is electronic and network-capable, it would have been obvious to one of ordinary skill at the time of the invention to have communicated the necessary information (profiles, lists, merchant products, merchant list of regular custoemrs)

between any two entities over a network so that the desired teargeting of potential custyomer can be accomplished.

Regarding claim 8, DiStefano, III teaches that the targeted ads can be scheduled for future delivery [6:20-22]. It would have been obvious to one of ordinary skill at the time of the invention to have allowed last minute changes/deletions/additions to the user profiles so that delivery of the targeted ads can be sent to the most recently accurate subset/list of consumers.

6. **Claims 4, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiStefano, III in view of Gardenswartz et al, Goldstein and Hoffberg (US6252544).**

7. Official Notice is taken that it is well known to charge the manufacturer as well as retailer/shop for provided advertising. Hoffberg teaches that advertising costs can be recovered by charging per ad impression. If would have been obvious to one of ordinary skill at the time of the invention to have charged the ad provider as well as the retail store for advertising based on each delivered ad. As stated above, applicant's claims do not require any distinction between prospective customers and "regular" customers. Both are treated as mere "consumers" at this time. A unit fee for each recipient can be the same for those consumers who may be considered by applicant as prospects and those considered by applicant as regular customers – such would read on the claimed fee arrangement; the shop/retailer pays a certain amount for the total number of ads sent.

8. **Claims 5, 12, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiStefano, III in view of Gardenswartz et al, Goldstein and Gough et al (US6360221).**

9. Official Notice is taken that it is well known to charge the manufacturer as well as retailer for provided advertising. Gough et al teaches that advertising costs can be recovered by charging per sale generated by the ad recipient. If would have been obvious to one of ordinary skill at the time of the invention to have charged the ad provider as well as the retail store for advertising based on each successful sale.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. In particular see the discussion of newly cited Goldstein above.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

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jdc